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09/988,338	11/19/2001	Jean Sini	19111.0061	8546

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EXAMINER

HUTTON JR, WILLIAM D

ART UNIT	PAPER NUMBER
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2176

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	12/21/2006	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

09/988,338

Applicant(s)

SINI ET AL.

Examiner

Doug Hutton

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 November 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3,5-11,13-19 and 21-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3,5-11,13-19 and 21-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 November 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application
- ☐ Other: _____.

Applicant's Response

In Applicant's Response dated 11/06/2006, Applicant amended Claims 1, 9 and 17, and argued against all rejections previously set forth in the Office Action dated 05/04/2006.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3, 9-11, 17-19 and 25-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Immonen et al., U.S. Patent Application Publication No. US 2002/0077993 A1 (hereinafter, Immonen), in view of Major et al., U.S. Patent Application Publication No. US 2004/0073626 A1 (hereinafter, Major).

Claim 1:

Immonen discloses *a method for automatically translating content* (see Figure 1; see Page 1, Paragraph 0005 → Immonen discloses this limitation in that the prior art includes a WAP gateway that translates web content from an HTML format to a WML format for display on a mobile device), *comprising the steps of:*

- *invoking an application program in response to an indication from a user of a mobile device to do so* (see Figures 3-5; see Page 3, Paragraph 0039 through

Page 5, Paragraph 0057 → Immonen discloses this limitation in that the system for conducting wireless payments comprises a mobile user accessing e-commerce web pages);

- *scanning content generated by the application program to locate at least one translatable form that requests information from the user* (see Figures 1 and 3-5; see Page 1, Paragraph 0005; see Page 3, Paragraph 0039 through Page 5, Paragraph 0057 → Immonen discloses this limitation in that the prior art includes a WAP gateway that translates web content from an HTML format to a WML format for display on a mobile device. Web content includes forms for use in e-commerce. In Immonen, the system for conducting wireless payments comprises a mobile user making an online purchase using a digital wallet.);
- *analyzing the located translatable form* (see Figures 1 and 3-5; see Page 1, Paragraph 0005; see Page 3, Paragraph 0039 through Page 5, Paragraph 0057 → Immonen discloses this limitation in that the prior art includes a WAP gateway that translates “web content” from an HTML format to a WML format for display on a mobile device. “Web content” includes forms for use in e-commerce that requests information from the user. Thus, the prior art translators would have located any HTML form that was part of the web content (i.e., “*analyzing the form*”) before translating the form into a WML format for display on the mobile device. Moreover, Immonen discloses this limitation in that the system for conducting wireless payments comprises a mobile user making an online purchase using a digital wallet. During the online purchase, the user receives an

electronic invoice that requests information from the user. Thus, in order to transmit an electronic invoice written in HTML to a user on a mobile device, the system includes a web application that handles the online purchase, wherein, before transmitting the electronic invoice to the mobile device, the content of the web page is scanned to locate all content on the page (i.e., "*analyzing the form*") in order to translate the content from an HTML format to a WML format. In this way, the contents of a digital wallet is converted into a format that is understood by the WAP gateway.); and

- *translating the located translatable form transmitted from the application program from an initial format of the form to a format supported by the mobile device, the format supported by the mobile device being different than the initial format of the content, wherein the translatable form is analyzed and translated prior to transmission to the mobile device* (see Figures 1 and 3-5; see Page 1, Paragraph 0005; see Page 3, Paragraph 0039 through Page 5, Paragraph 0057 →

Immonen discloses this limitation in that the prior art includes a WAP gateway that translates "web content" from an HTML format to a WML format for display on a mobile device. "Web content" includes forms for use in e-commerce that requests information from the user. Thus, the prior art translators would have located any HTML form that was part of the web content (i.e., "*analyzing the form*") and translated the form into a WML format for display on the mobile device **prior** to transmitting the form to the mobile device. Moreover, Immonen discloses this limitation in that the system for conducting wireless payments

comprises a mobile user making an online purchase using a digital wallet.

During the online purchase, the user receives an electronic invoice that requests information from the user. Thus, in order to transmit an electronic invoice written in HTML to a user on a mobile device, the system includes a web application that handles the online purchase, wherein, before transmitting the electronic invoice to the mobile device, the content of the web page is scanned to locate all content on the page (i.e., "*analyzing the form*") in order to translate the content from an HTML format to a WML format. In this way, the contents of a digital wallet is converted into a format that is understood by the WAP gateway.); *and*

- *transmitting the translated form to the mobile device* (see Figures 3-5; see Page 3, Paragraph 0039 through Page 5, Paragraph 0057 → Immonen discloses this limitation in that the system for conducting wireless payments comprises a process for transmitting the contents of the digital wallet to a mobile device in order to facilitate making an online purchase using a mobile device).

Immonen fails to expressly disclose:

- *analyzing the located translatable form to **determine a format supported by the mobile device.***

Major teaches *a method for automatically translating content* (see Abstract →

Major teaches this limitation, as clearly indicated in the cited text), *comprising the step of:*

- *analyzing located content to determine a format supported by a mobile device*
(see Paragraphs 0075-0077 → Major teaches this limitation in that the wireless device browser system determines whether the wireless device has a suitable converter, and, if not, converts the content to the appropriate format); *and*
- *translating the located content from an initial format of the content to a format supported by the mobile device, wherein the translatable form is analyzed and translated prior to transmission to the mobile device* (see Paragraphs 0075-0077 → Major teaches this limitation in that the wireless device browser system determines the type or format of the content, determines whether the wireless device has a suitable converter, and, if not, converts the content to an appropriate format before transmitting it to the wireless device and subsequently transmits it to the wireless device.),

for the purpose of rendering Web content on a wireless device browser (see Paragraph 0017).

Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method for automatically translating content, disclosed in Immonen, to include:

- *analyzing the located translatable form **to determine a format supported by the mobile device,***

for the purpose of rendering Web content on a wireless device browser, as taught by Major.

Claim 2:

Immonen discloses *[an] initial format of the content [that] is wireless markup language, extensible markup language, or hypertext markup language* (see Figure 1; see Page 1, Paragraph 0005 → Immonen discloses this limitation in that the prior art includes a user making a WML request to the WAP gateway by specifying a URL using the mobile device).

Claim 3:

Immonen discloses *[a] format supported by the mobile device [that] is wireless markup language, extensible markup language, or hypertext markup language* (see Figure 1; see Page 1, Paragraph 0005 → Immonen discloses this limitation in that the prior art includes a WAP gateway that translates web content in an HTML format into a WML format for display on a mobile device).

Claim 25:

Immonen discloses *[a] form [that] is filled-in with information relating to the user before being translated* (see Figures 3-5; see Page 3, Paragraph 0039 through Page 5, Paragraph 0057 → Immonen discloses this limitation in that the system for conducting wireless payments comprises a mobile user making an online purchase using a digital wallet).

Claim 9:

Claim 9 corresponds to Claim 1 in that it recites a computer system that performs the method recited in Claim 1.

Additionally, Immonen discloses *a system for automatically translating content* (see Figure 1; see Page 1, Paragraphs 0002-0005 → Immonen discloses this limitation in that the prior art includes a computer system comprising a WAP gateway that translates web content in an HTML format into a WML format for display on a mobile device), *comprising:*

- *a processor operable to execute computer program instructions* (see Figure 1; see Page 1, Paragraphs 0002-0005 → Immonen discloses this limitation in that the prior art includes the Internet and users accessing the Internet via computers. Because Immonen discloses computers accessing the Internet, Immonen also discloses a “*processor operable to execute computer program instructions.*”); and
- *a memory operable to store computer program instructions executable by the processor* (see Figure 1; see Page 1, Paragraphs 0002-0005 → Immonen discloses this limitation in that the prior art includes the Internet and users accessing the Internet via computers. Because Immonen discloses computers accessing the Internet, Immonen also discloses a “*memory operable to store computer program instructions executable by the processor.*”).

As indicated in the above rejection for Claim 1, Immonen, in view of Major, discloses/teaches every remaining limitation in Claim 9 and provides proper motivation to combine the teachings of Major with the disclosure of Immonen.

Claims 10 and 11:

Claims 10 and 11 correspond to Claims 2 and 3, respectively. Thus, Immonen, in view of Major, discloses/teaches the limitations expressly recited in Claims 10 and 11, as indicated in the above rejections for Claims 2 and 3.

Claim 26:

Claim 26 corresponds to Claim 25. Thus, Immonen, in view of Major, discloses/teaches the limitation expressly recited in Claim 26, as indicated in the above rejection for Claim 25.

Claim 17:

Claim 17 corresponds to Claim 1 in that it recites computer software that performs the method recited in Claim 1.

Additionally, Immonen discloses *a computer program product for automatically translating content* (see Figure 1; see Page 1, Paragraphs 0002-0005 → Immonen

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discloses this limitation in that the prior art includes a computer system comprising a WAP gateway that translates web content in an HTML format into a WML format for display on a mobile device. The functionality of the computer system is executed through a "*computer program product.*"), *comprising:*

- *a computer readable medium* (as indicated in the above discussion, Immonen discloses this limitation); *and*
- *computer program instructions, recorded on the computer readable medium, executable by a processor* (as indicated in the above discussion, Immonen discloses this limitation).

As indicated in the above rejection for Claim 1, Immonen, in view of Major, discloses/teaches every remaining limitation in Claim 17 and provides proper motivation to combine the teachings of Major with the disclosure of Immonen.

Claims 18 and 19:

Claims 18 and 19 correspond to Claims 2 and 3, respectively. Thus, Immonen, in view of Major, discloses/teaches the limitations expressly recited in these claims, as indicated in the above rejections for Claims 2 and 3.

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Claim 27:

Claim 27 corresponds to Claim 25. Thus, Immonen, in view of Major, discloses/teaches the limitation expressly recited in Claim 27, as indicated in the above rejection for Claim 25.

Claims 5-8, 13-16 and 21-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Immonen, in view of Major, and further in view of Dutta et al.; U.S. Patent No. 6,615,212 (hereinafter, Dutta).

Claim 5:

As indicated in the above rejection, Immonen, in view of Major, discloses/teaches every element of Claim 1.

Immonen, in view of Major, fails to expressly disclose/teach:

- *translating the form transmitted from the application program from the initial format of the form to an intermediate format of the form, wherein the intermediate format is different than the initial format; and*
- *translating the intermediate format of the form to the format supported by the mobile device, wherein the intermediate format is different than the format supported by the mobile device.*

Dutta teaches *a method for automatically translating content* (see Figure 4; see Column 1, Lines 9-11 → Dutta teaches this limitation, as clearly indicated in the cited figure and text), *comprising the steps of:*

- *translating the content transmitted from the application program from the initial format of the content to an intermediate format of the content, wherein the intermediate format is different than the initial format* (see Column 6, Lines 47-58; see Column 8, Lines 23-43 → Dutta teaches this limitation in that the transcoding proxy server transcodes the content from the origin server into an intermediate format that is different from the original format of the content); *and*
- *translating the intermediate format of the content to the format supported by the mobile device, wherein the intermediate format is different than the format supported by the mobile device* (see Column 6, Lines 47-58; see Column 8, Lines 23-43 → Dutta teaches this limitation in that the transcoding proxy server transcodes the content in the intermediate format into a final format that is different from the intermediate format and transmits it to the wireless device),
for the purpose of minimizing content transmission times (see Column 2, Lines 25-35).

Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method for automatically translating content, disclosed/taught in Immonen, in view of Major, to include:

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- *translating the content transmitted from the application program from the initial format of the content to an intermediate format of the content, wherein the intermediate format is different than the initial format; and*
- *translating the intermediate format of the content to the format supported by the mobile device, wherein the intermediate format is different than the format supported by the mobile device,*

for the purpose of rendering Web content on a wireless device browser, as taught by Dutta.

Claims 6 and 8:

Claims 6 and 8 correspond to Claims 2 and 3, respectively. Thus Immonen, in view of Major, and further in view of Dutta, discloses/teaches the limitations expressly recited in these claims, as indicated in the above rejections for Claims 2 and 3.

Claim 7:

Immonen, in view of Major, fails to expressly disclose/teach *[an] intermediate format of the content [that] is wireless markup language, extensible markup language, or hypertext markup language.*

Dutta teaches a *method for automatically translating content, wherein the intermediate format of the content is wireless markup language, extensible markup language, or hypertext markup language* (see Column 6, Line 47 through Column 7, Line 12; see Column 7, Lines 56-62; see Column 8, Lines 23-43 → Dutta teaches this limitation in that the transcoding proxy server transcodes the content from the origin server into HTML or XML), for the purpose of minimizing content transmission times (see Column 2, Lines 25-35).

Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method for automatically translating content, disclosed/taught in Immonen, in view of Major, to include *an intermediate format of the content that is wireless markup language, extensible markup language, or hypertext markup language* for the purpose of rendering Web content on a wireless device browser, as taught by Dutta.

Claim 13 and 15:

Claims 13 and 15 correspond to Claims 5 and 7, respectively. Thus, Immonen, in view of Major, and further in view of Dutta, discloses/teaches the limitations of Claim 13 and 15, as indicated in the above rejections for Claims 5 and 7.

Claims 14 and 16:

Claims 14 and 16 correspond to Claims 6 and 8, respectively. Thus, Immonen, in view of Major, and further in view of Dutta, discloses/teaches the limitations expressly recited in Claims 14 and 16, as indicated in the above rejections for Claims 6 and 8.

Claim 21 and 23:

Claims 21 and 23 correspond to Claims 5 and 7, respectively. Thus, Immonen, in view of Major, and further in view of Dutta, discloses/teaches the limitations of Claim 21 and 23, as indicated in the above rejections for Claims 5 and 7.

Claims 22 and 24:

Claims 22 and 24 correspond to Claims 6 and 8, respectively. Thus, Immonen, in view of Major, and further in view of Dutta, discloses/teaches the limitations expressly recited in Claims 22 and 24, as indicated in the above rejections for Claims 6 and 8.

Response to Arguments

Applicant's arguments filed 11/06/2006 have been fully considered but they are not persuasive.

Arguments for Claims 1-3, 9-11, 17-19 and 25-27:

Applicant argues that Immonen and Major fails disclose or suggest “*analyzing the located translatable form to determine a format supported by the mobile device*” and “*translating the located translatable form transmitted from the application program from an initial format of the form to a format supported by the mobile device,*” “*wherein the translatable form is analyzed and translated prior to transmission to the mobile device,*” because:

1. Immonen fails to disclose analyzing the located translatable form to determine a format supported by the mobile device; and
2. Major performs the analysis and translation at the browser after the content is received and stored in a cache at the client.

See *Response* – Page 9, last paragraph through Page 11, first partial paragraph.

The examiner disagrees.

Initially, Applicant argues against the references individually, and one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Immonen discloses “*analyzing the located translatable form*” in that the system determines whether the content is available only in HTML format before translating the content into WML and transmitting it to the client, as admitted by Applicant (see *Response* – Page 10, first full paragraph, second sentence). As indicated in the above rejections, Applicant is correct in stating that Immonen fails to disclose “*analyzing the*

located translatable form to determine a format supported by the mobile device."

However, Major teaches this limitation, as indicated in the above rejections.

In regard to Applicant's argument that Major performs the analysis and translation at the browser **after** the content is received and stored in a cache at the client, the examiner notes that Major is used only to teach "*analyzing [content] to determine a format supported by the mobile device,*" as indicated in the above rejections. Moreover, Major expressly teaches that:

1. the IP proxy server may comprise filters to convert retrieved content into a compressed format for transmission over the appropriate format; and
2. filters may be implemented in the IP proxy server to convert retrieved content into other formats **that can be processed at the receiving device** (*i.e.*, the client browser).

See Page 6, Paragraph 0072.

Accordingly, Immonen, in view of Major, discloses/teaches a translatable form that is analyzed and translated **prior** to transmission to the mobile device.

Arguments for All Remaining Claims:

Applicant's arguments for the remaining claims mirror the arguments submitted for Claims 1-3, 9-11, 17-19 and 25-27. As indicated in the above discussion, the examiner disagrees.

Conclusion

All claims are drawn to the same invention claimed in the application prior to the entry of the submission under 37 CFR 1.114 and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the application prior to entry under 37 CFR 1.114. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action after the filing of a request for continued examination and the submission under 37 CFR 1.114. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Doug Hutton whose telephone number is 571-272-4137. The examiner can normally be reached on Monday-Friday from 8:00 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon, can be reached at (571) 272-4136. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-2100.

WDH

December 17, 2006

A handwritten signature in black ink, appearing to read 'Doug Hutton', with a stylized flourish at the end.

Doug Hutton
Primary Examiner
Technology Center 2100